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10/535,492	05/17/2005	Hyung-Nam Choi	071308.0986 (2003P01541WO)	3927
86528	7590	02/25/2010	EXAMINER	
King & Spalding LLP 401 Congress Avenue Suite 3200 Austin, TX 78701			KASRAIAN, ALLAHYAR	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/535,492	Applicant(s) CHOI ET AL.	
	Examiner ALLAHYAR KASRAIAN	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13, 15-20 and 22-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13, 15-20 and 22-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

1. The present Office Action is based upon the Applicant's amendment filed on Nov. 23, 2009. **Claims 13, 15-20 and 22-26** are now pending in the present application.

This Action is made FINAL.

Response to Arguments

2. Applicant's arguments with respect to claims 13, 15-20 and 22-26 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments with respect to limitations regarding providing at least one "third party service" have been fully considered but they are not persuasive (see rejection under 35 U.S.C. 112, the first paragraph).

In the fourth paragraph on page 7 of the Applicant's arguments/remarks, Applicant argues, "Claim 13 explicitly recites that all of the first, second, third and fourth items of network information are all *stored in the same second item of identification information*. Even assuming for the sake of argument that *Knauerhase* teaches first, second, third and fourth items of network information as the Examiner alleges (which Applicants obviously disagree), *Knauerhase* does not teach that these alleged first, second, third and fourth items of network information are *stored in the same item of identification information*." Examiner respectfully traversed in the argument. The claim is silent to what Applicant explicitly argues. Moreover, *Knauerhase* discloses the first, second, third and fourth items and all related to identifying and accessing through WLAN part of a mobile device.

Applicant(s) are reminded that the Examiner is entitled to give the broadest reasonable interpretation to the language of the claim. The Examiner is not limited to Applicant's definition, which is not specifically set forth in the claims, *In re Tanaka et al.* 193 USPQ 139, (CCPA) 1977.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 13, 15-19, 20 and 22-26** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claims 13, 20, and 26 contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite, "a third item of network information indicating *at least one third party service* provided by ***a third party via*** the local area network... *wherein the third party service comprises access to one or more applications offered at the location, and based at least on the first, second, third, and fourth items of network information, establishing and permitting a connection to a local wireless network to receive at least a portion of the third party service via the local area network.*" Further more Applicant argues, "*Further, Knauerhase* does not teach the limitations regarding providing at least one 'third party service.' The Examiner argues that *Knauerhase's* 'connectivity map' and access to it can be equated with the claimed third party service. However, the claimed

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'third party service' is not a service originated *by the terminal*, but rather *by another party*, in the network. Applicants have amended Claim 13 to make this limitation explicit -- that at least a portion of the third party service is *provided to the terminal via the local area network*. In contrast, the portions of *Knauerhase* cited by the Examiner teach that the terminal restricts the connectivity map it is offering, which is essentially the opposite of amended Claim 13. Further, Claim 13 explicitly recites that the third party service *comprises access to one or more applications*. *Knauerhase* 'connectivity map' is not an application, but rather basic information regarding local connectivity options." However, there is nothing the specification to disclose "a third party service provided by a third party", "establishing and permitting a connection to a local wireless network to receive at least a portion of the third party service" and "the third party service comprises access to one or more applications".

Applicant is welcomed to point out where in the specification supports the limitations and his argument.

In contrast, par. 0015 of the specification merely discloses, "a third item of information about *at least one service* provided by the local area network"; par. 0086, merely discloses, "the WLAN Application Code (WAC) comprises a maximum of three digits (decimal) and uniquely identifies the WLAN *application*"; and par. 0095-00101 and 00105 and 00106 only discloses the Application codes such as Airport, Hotel, Station or Coffee Shop. There is nothing to disclose about "the service and application provided or offered by the third party".

Claims 15-19 and 22-25 are also rejected by the virtue of their dependency on

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claims 13 and 20.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. **Claims 13, 15, 16, 20, 22, and 23** are rejected under 35 U.S.C. 103(a) as being

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unpatentable over **Knauerhase et al. (US Patent # 6941146)** (hereinafter Knauerhase) in view of **Tuomi (US Patent Application Pub. # 20040093418)**.

Consider **claims 13 and 20**, Knauerhase discloses a method for operating terminals of a mobile radio communication system, in at least one local wireless network, comprising:

storing a plurality of items of access information on a terminal, the access information including at least one first item of identification information for the mobile radio communication system, and at least one second item of identification information for a local area network, the second item of identification information comprising (FIGS.1, 3 for items of access information 302, 304 and 306 for how to connect to specific communication standard system, and FIG. 4 for connectivity for transceiver 208, col. 2 lines 10-16 and 44-53, col. 3 lines 27-48; the identification information are inherent with regards to connectivity to a certain item, e.g. the MS will be identified if it can connect to 802.11 or cellular network):

a first item of network information indicating the location of the local area network (col. 3 lines 27-43),

a second item of network information indicating the type of the local area network (FIG. 1 for region/sub-region 802.11 a and/or b, col. 2 lines 10-13 and 23-28 for types of network connectivity, col. 2 line 67-col. 3 line 9 for 802.11a or 802.11b types; FIG 3. for Bluetooth type or 802.11 family type), and

a third item of network information indicating at least one third party service

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provided by a third party via the local area network, wherein the third party service comprises access to one or more applications offered at the location (FIG. 1 for map server(s) 102, col. 2 lines 23-56, map server 102, an regional map servers provide the client global coverage map to inform the client of connectivity options; FIG. 5, col. 4 lines 1-57); and

a fourth item of network information uniquely identifying the local area network (col. 3 lines 27-48; FIG. 5, col. 4 lines 13-21);

requesting a connection to the local wireless network via the terminal (col. 3, lines 21-43);

accessing the stored information (col. 6 lines 45-62).

However, Knauerhase fails to explicitly disclose based at least on the first, second, third, and fourth items of network information, establishing and permitting a connection to a local wireless network to receive at least a portion of the third party service via the local area network.

In the same field of endeavor, Tuomi discloses based at least on the first, second, third, and fourth items of network information, establishing and permitting a connection to a local wireless network to receive at least a portion of the third party service via the local area network (par. 0034-0038 with combination with par. 0031 (for disclosing USIM card); consider APN information as the third item for providing a certain service at a certain location which is considered as the third party service; the user is also authenticated for a connection to WLAN network).

Therefore, it would have been obvious to a person of ordinary skill in the art at

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the time the invention was made to incorporate authenticating a user to access a WLAN network at the certain location with a certain service as taught by Tuomi to method of connecting and receiving a service (connectivity map) at a certain location disclosed by Knauerhase for purpose of connecting to an access point to receive a service..

Consider **claims 15 and 22 as applied to claim 13 and 20 above respectively**, Knauerhase as modified by Tuomi discloses the claimed invention except the first, second, and/or third items of network information are encoded by means of a maximum of three decimal digits.

Examiner takes an **Official Notice** that the advantages of limiting and standardizing the size of stored information is well known and expected in the art.

Therefore, it would have been obvious to one ordinary skill in the art to make any kind of restriction on size of encoding data due to the known limited amount of storage on wireless communication devices and to provide a consistent manner of storing this information on the device.

Consider **claims 16 and 23 as applied to claim 14 and 21 above respectively**, Knauerhase as modified by Tuomi discloses the claimed invention except the fourth item of network information is encoded by means of a maximum of five decimal digits.

Examiner takes an **Official Notice** that the advantages of limiting and standardizing the size of stored information is well known and expected in the art.

Therefore, it would have been obvious to one ordinary skill in the art to make any

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kind of restriction on size of encoding data due to the known limited amount of storage on wireless communication devices and to provide a consistent manner of storing this information on the device.

9. **Claims 17-19, 24, and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Knauerhase et al. (US Patent # 6941146)** (hereinafter Knauerhase) in view of **Tuomi (US Patent Application Pub. # 20040093418)** in view of **Haverinen et al. (US Patent Application Pub. # 20030119481)** (hereinafter Haverinen).

Consider **claims 17 and 24 as applied to claim 13 and 20 above respectively**, Knauerhase as modified by Tuomi discloses the claimed invention except the second items of identification information are stored as a first list organized in such a way that the first list contains those second items of identification information that are assigned to local area networks which allow the operation of the terminal within the local area network.

In the same field of endeavor, Haverinen discloses the second items of identification information are stored as a first list organized in such a way that the first list contains those second items of identification information that are assigned to local area networks which allow the operation of the terminal within the local area network (par. 0042).

Therefore, it would have been obvious to a person of ordinary skills in the art at the time the invention was made to incorporate list of accessible network IDs as taught

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by Haverinen to the client device memory as disclosed by Knauerhase as modified by Tuomi for purpose of authenticating and authorizing a mobile connection to a specific network.

Consider **claims 18 and 25 as applied to claim 14 and 20 above respectively**, Knauerhase as modified by Tuomi discloses the claimed invention except the second items of identification information are stored as a first list organized in such a way that the first list contains those second items of identification information that are assigned to local area networks which forbid the operation of the terminal within the local area network.

In the same field of endeavor, Haverinen discloses the second items of identification information are stored as a first list organized in such a way that the first list contains those second items of identification information that are assigned to local area networks which forbid the operation of the terminal within the local area network (par. 0042).

Therefore, it would have been obvious to a person of ordinary skills in the art at the time the invention was made to incorporate list of forbidden network IDs as taught by Haverinen to the client device memory as disclosed by Knauerhase as modified by Tuomi for purpose of authenticating and authorizing a mobile connection to a specific network.

Consider **claim 19 as applied to claim 13 above**, Knauerhase as modified by

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Tuomi discloses the claimed invention except the at least first item of access information is stored on a device serving for user identification, in particular a USIM module.

In the same field of endeavor, Haverinen discloses the at least first item of access information is stored on a device serving for user identification, in particular a USIM module (par. 0042).

Therefore, it would have been obvious to a person of ordinary skills in the art at the time the invention was made to incorporate a USIM module as disclosed by Haverinen to the client device as disclosed by Knauerhase as modified by Tuomi for purpose of utilizing the network identifiers which are stored for allowing the client to connect to a specific network.

10. **Claim 26** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Knauerhase et al. (US Patent # 6941146)** (hereinafter Knauerhase) in view of **Tuomi (US Patent Application Pub. # 20040093418)** in view of **Rao et al. (US Patent Application Pub. # 20040076128)** (hereinafter Rao).

Consider **claim 26**, Knauerhase discloses a method for operating terminals of a mobile radio communication system, in at least one local wireless network, comprising:
storing a plurality of items of access information on a terminal, the access information including at least one first item of identification information for the mobile radio communication system, and at least one second item of identification information

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for a local area network, the second item of identification information comprising (FIGS. 1, 3 for items of access information 302, 304 and 306 for how to connect to specific communication standard system, and FIG. 4 for connectivity for transceiver 208, col. 2 lines 10-16 and 44-53, col. 3 lines 27-48; the identification information are inherent with regards to connectivity to a certain item, e.g. the MS will be identified if it can connect to 802.11 or cellular network):

a first item of network information indicating the location of the local area network (col. 3 lines 27-43),

a second item of network information indicating the type of the local area network (FIG. 1 for region/sub-region 802.11 a and/or b, col. 2 lines 10-13 and 23-28 for types of network connectivity, col. 2 line 67-col. 3 line 9 for 802.11a or 802.11b types; FIG 3. for Bluetooth type or 802.11 family type),

a third item of network information indicating at least one third party service provided by a third party via the local area network, wherein the third party service comprises access to one or more applications offered at the location (FIG. 1 for map server(s) 102, col. 2 lines 23-56, map server 102, an regional map servers provide the client global coverage map to inform the client of connectivity options; FIG. 5, col. 4 lines 1-57), and

a fourth item of network information uniquely identifying the local area network (col. 3 lines 27-48; FIG. 5, col. 4 lines 13-21); and

However, Knauerhase fails to explicitly disclose based at least on the first, second, third, and fourth items of network information, establishing and permitting a

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connection to a local wireless network to receive at least a portion of the third party service via the local area network.

In the same field of endeavor, Tuomi discloses based at least on the first, second, third, and fourth items of network information, establishing and permitting a connection to a local wireless network to receive at least a portion of the third party service via the local area network (par. 0034-0038 with combination with par. 0031 (for disclosing USIM card); consider APN information as the third item for providing a certain service at a certain location which is considered as the third party service; the user is also authenticated for a connection to WLAN network).

However, Knauerhase as modified by Tuomi fails to disclose the location of the local area network based on a mobile country code that uniquely identifies the country in which the local area network is operated.

In the same field of endeavor, Rao discloses the location of the local area network based on a mobile country code that uniquely identifies the country in which the local area network is operated (par. 0024).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the IMSI number which is a combination of mobile country code that identifies the country of WLAN operation as taught by Rao to the region where the mobile have connectivity to 802.11 network as disclosed by Knauerhase as modified by Tuomi for purpose of expanding the connectivity network on the map server for providing international connectivity map.

Conclusion

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11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

- a. Jana et al. (U.S. Patent Application Publication # 20030096621) disclose Method and apparatus for identifying a group of users of a wireless service.
- b. Kall et al. (U.S. Patent Application Publication # 20040203914) disclose Provision of location information in a communication system.
- c. Myers et al. (U.S. Patent Application Publication # 20040122956) disclose Wireless local area communication network system and method.

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13. Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

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Hand-delivered responses should be brought to

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Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Allahyar Kasraian whose telephone number is (571) 270-1772. The Examiner can normally be reached on Monday-Thursday from 8:00 a.m. to 5:00 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Rafael Pérez-Gutiérrez can be reached on (571) 272-7915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

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applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 571-272-4100.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

/Allahyar Kasraian/

Examiner, Art Unit 2617

A.K./ak

/Rafael Pérez-Gutiérrez/

Supervisory Patent Examiner, Art Unit 2617